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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/273,021	03/19/1999	HAROLD W. MILTON JR.	MILT.777	6459

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EXAMINER

YANG, GRANT C

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 04/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/273,021

Applicant(s)

MILTON, HAROLD W.

Examiner

Grant C Yang

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 April 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. This Non-final rejection is responsive to Letter of Missing Parts filed 4/8/99, Small entity filed 4/26/99, and the preliminary amendment filed 4/26/99.

#### *Specification*

2. The abstract of the disclosure is objected to because the word "fir" on line 1 should be "for". Correction is required. See MPEP § 608.01(b).

#### *Claim Rejections - 35 USC § 112*

3. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-20 the parenthesized numbers that are added in the independent claims and some of the dependent claims are confusing and indefinitely disclose the invention. If a step is in a number then properly disclose the step. Correction is required.

Regarding claim 9, it is unclear why abstract sentences are also taken from the DESCRIPTION OF THE PREFERRED EMBODIMENT. For now it is ignored in the claim.

#### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman, U.S. Patent No. 5,774,833, published Jun. 30, 1998 in view of Nehab, U.S. Patent No. 6,029,182, filed Oct. 4, 1996, published Feb. 22, 2000 and Manual of Patent Examining Procedure, 7<sup>th</sup> edition, published July 1998, herein known as MPEP.**

Regarding independent claim 1, Newman discloses the word processing program to store information about the patent, as on column 6, lines 20-22, and having a page break before the CLAIMS heading, as on column 8, lines 20-21, and having a page break before the ABSTRACT OF THE DISCLOSURE heading, as on column 8, lines 20-21, making sure that dependent claims have antecedent basis on its prior or independent claims, as **claim analysis results in the identification of what is known in the patent art as antecedent basis**, as on column 4, lines 27-32, and storing a duplicate set of dependent claims, as Newman's system load's the patent application one section at a time into memory to be processed, as on column 3, lines 16-20. However, Newman does not expressly disclose having a document template, footer with attorney identification, or the exact format of the headings.

However, Nehab discloses that a **predefined document templates exist**, and you can have **personalized templates either by editing existing templates or by creating new ones**, as on column 8, lines 11-15. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use a document template to store the format. One of ordinary skill in the art would have been motivated

to do this because it is notoriously well known in the art that templates are an easy way to store a specific layout of a document.

Nehab also discloses that the outputted formats can have headers and footers, as on column 24, line 53. However, Nehab does not expressly disclose that the footer information will contain the information of the attorney file identification. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add footer information. One of ordinary skill in the art would have been motivated to do this because it is notoriously well known to put textual information that is repeated on every page to be placed in a footer.

Furthermore, the following guidelines, found in the MPEP under section 601, illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

**As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:**

- (a) TITLE OF THE INVENTION.**
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.**
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.**
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)**
- (e) BACKGROUND OF THE INVENTION.**
  - (1) Field of the Invention.**

**(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.**

**(f) BRIEF SUMMARY OF THE INVENTION.**

**(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).**

**(h) DETAILED DESCRIPTION OF THE INVENTION.**

**(i) CLAIM OR CLAIMS (commencing on a separate sheet).**

**(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).**

**(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).**

Furthermore, the attorney's or agent's full post office address and other contact information must be given in every power of attorney, MPEP 601.02. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have the document template formatted to that of the MPEP. One of ordinary skill in the art would have been motivated to do this because document templates are essentially layouts that are pre-created, and a patent template would want to have the layout specified by patent law.

Regarding dependent claim 2, Newman discloses a **patent analyzer program that determines correction for the text and replacing the highlighted text**, as on column 6, lines 56-62. However, Newman does not expressly disclose replacing the word "said" with the word "the" to create a *grammatically correct sentence structure in the specification*; however, the MPEP discloses that the abstract may not have legal phraseology like "means" and "said," at MPEP 608.01(b).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to replace the words in the specification to be grammatically

correct and to have a correct format. One of ordinary skill in the art would have been motivated to do this because a patent application should have the format and proper grammar as specified by patent law in the MPEP.

Regarding dependent claim 3, Newman does not expressly disclose a direct copying of the claim and the summary; however, Newman does disclose that the claims must have antecedent basis from the specification, as on column 13, lines 25-30. Furthermore, the replacement of "said" with "the" is rejected similarly above.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use the independent claim in the SUMMARY OF THE INVENTION AND ADVANTAGES. One of ordinary skill in the art would have been motivated to do this because it would save much time, if the claims were written clearly, to simply use the independent claim, which is generally the broadest aspect of the invention, and have it rewritten in the specification.

Regarding dependent claims 4-7, Newman does not expressly disclose storing the first and second element names, searching for their occurrences, and selecting the numbers identifying the reference numerals and reference element names; however, Newman does disclose reading in the sections of the patent as disclosed above, and also teaches analysis to **verify that figures referenced agree with figures mentioned in the brief description section**, as on column 8, lines 57-60.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to store the reference numbers and match them up with their respective element names. One of ordinary skill in the art would have been motivated

to do this because it is important when verifying figures and references that they have the same format required by patent law, which requires them to correctly match with element names and have proper antecedent basis.

Regarding dependent claim 8, Newman does not expressly disclose alternative phrasing of edit clauses of the duplicate set of claims; however, Newman does disclose the **patent analyzer program can replace highlighted text that needs correction**, as on column 6, lines 58-63.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to interspersing alternative phrasing of edited clauses of the claims. One of ordinary skill in the art would have been motivated to do this because a lot of the specification comes from the claims and vice versa, and if claims need correcting or editing then it would most likely need to correlate with the specification in order to not lack an antecedent basis.

Regarding dependent claim 9, Newman does not expressly disclose storing the abstract sentences retrieved from the heading ABSTRACT OF THE DISCLOSURE; however, Newman discloses that the patent analyzer has its own working memory to store information and analyze the text, as on column 6, lines 20-25.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to store the information of the text; in particular, one would want to retrieve abstract sentences from under the heading ABSTRACT OF THE DISCLOSURE. One of ordinary skill in the art would have been motivated to do this because one would want to store the analyzing text to parse in a separate memory from



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the actual word processor program in order to have ease of version management.

Furthermore, one would want to get abstract sentences from the ABSTRACT because by definition the sentences under the ABSTRACT heading are most likely sentences of the abstract.

Regarding dependent claim 10, Newman does not expressly disclose storing the reference numbers; however, as disclosed above Newman does disclose the patent analyzer program having its own memory and needing to store all the elements of the patent application, which includes the reference numbers imbedded in the specification and drawings. Furthermore, Newman does not expressly disclose adding parenthesis around the reference numbers; however, the MPEP 608.01 (m) states that **reference characters corresponding to element recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. The reference characters, however, should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims.**

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add parentheses to the reference numbers in the claims and abstract. One of ordinary skill in the art would have been motivated to do this because as stated before it would be better to place parentheses around reference numbers, and furthermore if the template is for a patent application one would want the layout to coincide with the patent laws as much as possible.

Regarding dependent claims 11-15 and 16, Newman does not expressly disclose drafting sentences for the Technical Field, Prior Art, Summary of the Invention, Related Applications, and the Brief Description of the Drawings. But as stated above, the specification requires having all these headings and is further explained in MPEP 601.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have the headings and their respective descriptive statements underneath the headings. One of ordinary skill in the art would have been motivated to do this because in order to have an appropriate template for patent applications, one would have wanted to properly conform to the current edition of the MPEP.

Regarding dependent claim 17, Newman discloses verifying and identifying the numbered figure elements in paragraph 1 of the detailed description, as on column 9, lines 1-4.

Regarding dependent claim 18, Newman does not expressly disclose adding a paragraph before the claims stating the effect that the invention has *many modifications and variations*; however, it is notorious in the art to have a paragraph before the claims asserting that the invention is limited by the description described. Newman gives an example stating **the present invention has been described above with reference to preferred embodiments. However, those skilled in the art will recognize that changes and modifications may be made in these preferred embodiments without departing from the scope of the present invention**, as on column 14, lines 39-44.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add a statement asserting variations of the invention are possible in light of the teachings. One of ordinary skill in the art would have been motivated to do this because it is not only well known in the art to include a statement specifying the variability of the invention in regards to the scope of the invention.

Regarding independent claim 20 are a method and a computer program and computer directed to the limitations of the combined limitations of claims 1-18 and are similarly rejected as above.

6. **Claim 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Nehab and the prior art as applied to claim 14 above, and further in view of Hunter, U.S. Patent No. 6,327, filed Mar. 8, 1995, published Oct. 2, 2001.**

Regarding dependent claim 17 Newman does not expressly disclose always adding the statement *Other advantages of the present invention will be readily appreciated as the same becomes better understood by reference to the following detailed description when considered in connection with the accompanying drawings wherein: ...*; however, it is notorious and well known to add a sentence similar to that as Hunter discloses **The features of the invention will be better understood by reference to the accompanying drawings which illustrate presently preferred embodiments of the invention, as shown in column 6, lines 30-35.**

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add in a paragraph stating the advantages in the invention are better appreciated in the drawings. A person of ordinary skill in the art would have been motivated to do this because it is notoriously well known to add these types of statements to clarify the patent application and in addition it is a common practice among patent applications to add a statement to that effect.

**Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,175,681

U.S. Patent No. 5,754,840

U.S. Patent No. 5,623,681

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Grant C. Yang whose telephone number is 703-305-1828. The examiner can normally be reached on Mon-Fri (8:30am-6pm) every other Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on 703-308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

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Any inquiry of a general nature relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

GY  
March 28, 2002

  
STEPHEN S. HONG  
PRIMARY EXAMINER

**Attachment for PTO-948 (Rev. 03/01, or earlier)**  
**6/18/01**

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes **incorporated** therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.